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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,265	01/21/2004	Kia Silverbrook	SMA10US	1040
24011 7590 04/13/2009 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER ANTONIENKO, DEBRA L				
ART UNIT		PAPER NUMBER		
3689				
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04/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/760,265

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

DEBRA ANTONIENKO

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.4.5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.4.5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 7, 2009 has been entered.

2. This is a Non-Final Office Action in response to communications received January 7, 2009, wherein:

Claims 1, 4, 5, and 7-9 have been amended;

Claims 2, 3, 6, 10, and 11 have been cancelled; and

Claims 1, 4, 5, and 7-9 are pending.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4, 5, 7-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 7, 10, 11, 15, 19, and 22 of U.S. Patent No. 7,111,935. Although the conflicting claims are not identical, they are not patentably distinct from each other because elements of the photofinishing system such as the cartridge, drier means, slitter means, feed means in the instant claims are recited in the claims of the above mentioned patent.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4, 5, and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent Claim 1 is a method of operating a business, therefore, the steps that follow should be steps of a process to operate the business. The steps of providing an image, processing the image, modifying the image, furnishing a print, and charging for the print are considered to be steps in a process to operate the claimed business, albeit well-known steps. However, the means for feeding paper or ink, the use of a particular cartridge, and effecting page-width printing relate to the structural limitations or method limitations of the photofinishing system, but not of operating the business. While the photofinishing system that incorporates a processor and printer is necessary to accomplish the steps of the business method and should be claimed, structural limitations or method limitations on the system that do not further define the steps of the business method change the scope of the claim to include both a process and a machine. Therefore, Claim 1 is considered to be a hybrid claim which fails to particularly point out and distinctly claim the invention. *Ex Parte Lyell*, 17 USPQ2d 1548 (BPAI. 1990).

Similarly, Claims 4, 5, and 7-9 recite that the paper/ink is fed/delivered on demand to the printer, the cartridge incorporates means for coupling, and the locations of a drier means, a slitter means, and a feed means are structural limitations of the system that do not further define or limit the method of operating the business.

Furthermore, to use a particular machine or system in a business that does not further define or limit the business method would be a business decision using common business sense, but it would not be invention. That is to say, a business owner might choose a photofinishing system with a particular cartridge set-up because it is more convenient or more efficient or delivers better quality prints or it was a good price or cost effective, but these are business considerations. The business process steps of providing an image, processing the image, modifying the image, furnishing a print, and charging for the print do not change.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire

reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

8. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto et al., U.S. Patent Number 5,974,401 (hereinafter Enomoto) in view of Silverbrook, U.S. Patent Application Publication Number 2002/0183088 A1 (hereinafter Silverbrook '088) in view of Silverbrook, U.S. Patent Number 6,362,868 (hereinafter Silverbrook '868).

Regarding Claim 1, Enomoto teaches a method of operating a photofinishing business comprising: utilizing a digital photofinishing system that incorporates a digital processor, a printer coupled to the digital processor, and means for feeding plain paper to the printer (column 2, lines 23-31; column 5, lines 8-18; Figure 2, element 31).

Enomoto does not explicitly teach the use of plain paper. However, Enomoto teaches the use of a variety of printers depending on what type of print the customer orders. Enomoto teaches the use of a *well-known ink jet type color digital printer* (column 5, lines 43-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to use plain paper in an ink jet printer in order to fulfill the customer's print order.

Enomoto further teaches providing the digital processor with digitised data from a source that is provided by a customer, and which is representative of a photographic image; processing the data with the digital processor to generate a printer drive signal that is representative of the photographic image (column 1, line 54 - column 2, line 5).

Enomoto does not explicitly teach said processing step including image modifications for modifying an appearance of the image. However, image modifications are well known in the art. It would be obvious to include image modifications in order to fulfill the customer's print order. Furthermore, the instant specification notes *using processing procedures that are known in the art...for effecting such image modifications as colour-to-black-and-white translation, sepia finishing, image rotation and image cropping* ([0070]-[0072]).

Enomoto further teaches furnishing the printed plain paper image to the customer and charging the customer for the printing service (column 2, lines 40-50). Enomoto teaches calculating the print charge and the delivery date. It is well known and obvious to deliver or furnish the print order to the customer on the delivery date and to charge the customer for the service after calculating the charge.

Enomoto does not teach providing the digital photofinishing system with a replaceable combined paper-ink cartridge storing a roll of plain paper and a supply of inks, said cartridge being slidably inserted into a housing portion of the photofinishing system to be engaged with a printhead of the printer and an ink feed means for feeding ink from the combined paper-ink cartridge to the printer;... in response to the drive signal, effecting page-width printing of the photographic image on the plain paper as it is fed directly to the printer from the combined paper-ink cartridge; and... wherein the step of effecting page-width printing of the photographic image includes matching a printing



speed to a rate at which the printer drive signal is generated, whereby the photographic image as a whole is printed at one constant speed.

However, Silverbrook '088 teaches providing the digital photofinishing system with a replaceable combined paper-ink cartridge storing a roll of plain paper and a supply of inks, said cartridge being slidably inserted into a housing portion of the photofinishing system to be engaged with a printhead of the printer and an ink feed means for feeding ink from the combined paper-ink cartridge to the printer ([0010]; [0014]; [0042]; [0048]; Figure 15);... in response to the drive signal, effecting page-width printing of the photographic image on the plain paper as it is fed directly to the printer from the combined paper-ink cartridge ([0011]; [0037]; [0042]). Examiner asserts that the replaceable combined paper-ink cartridge and effecting page-width printing would be a matter of design choice that does not affect the business process steps of providing an image, processing the image, modifying the image, furnishing a print, and charging for the print. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose a photofinishing system with replaceable combined paper-ink cartridge and effecting page-width printing if one so desired.

Silverbrook '868 teaches wherein the step of effecting page-width printing of the photographic image includes matching a printing speed to a rate at which the printer drive signal is generated, whereby the photographic image as a whole is printed at one constant speed (column 14, lines 23-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to choose a photographic system that prints at

a constant speed in order that the quality of the print is not compromised.

Regarding Claim 4, Enomoto does not teach wherein the roll of plain paper is fed on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism. However, Silverbrook '868 further discloses wherein the roll of print media is fed on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism (column 137, lines 20-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto with that of Silverbrook to feed paper to the printer in order to facilitate the printing process.

Regarding Claim 5, Enomoto does not teach wherein the supply of printing fluid is delivered on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism. However, Silverbrook '868 further discloses wherein the supply of printing fluid is delivered on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism (column 137, line 38 – column 138, line 23; Figure 164). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto with that of Silverbrook to supply ink and feed paper to the printer in order to facilitate the printing process.

Regarding Claim 9, Enomoto does not teach wherein the print media feed means is located in the replaceable combined paper-ink cartridge and drive means couple with the print media feed means to effect feeding of the print media through the printer. However, Silverbrook '868 further discloses wherein the print media feed means is located in the replaceable combined paper-ink cartridge and drive means couple with the print media feed means to effect feeding of the print media through the printer (column 137, lines 20-37; Figure 163). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto with that of Silverbrook to locate the feed means in the cartridge in order to facilitate the printing process.

9. **Claims 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Silverbrook '088 in view of Silverbrook '868 and further in view of Janosky et al., U.S. Patent Number 6,394,669 (hereinafter referred to as Janosky).

Regarding Claim 7, Enomoto, Silverbrook '088 and '868 do not teach wherein a drier means is coupled to the printer and the drier means receives printed media directly from the printer, to transport the printed media from the printer and to effect drying of the printed media during transportation of the media.

However, Janosky discloses wherein a drier means is coupled to the printer and the drier means receives printed media directly from the printer, to transport the printed media from the printer and to effect drying of the printed media during transportation of

the media (column 7, lines 20-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Silverbrook with that of Janosky to incorporate a drier in order to facilitate the printing process.

Regarding Claim 8, Enomoto, Silverbrook '088 and '868 do not teach wherein a slitter means is located in series with the printer and the slitter means receives printed media following its passage through the printer, transports the printed media in a direction away from the printer and slits the printed media in the longitudinal direction of transportation of the media.

However, Janosky discloses wherein a slitter means is located in series with the printer and the slitter means receives printed media following its passage through the printer, transports the printed media in a direction away from the printer and slits the printed media in the longitudinal direction of transportation of the media (column 8, lines 58-67; column 9, lines 1-2; Figure 5A). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Silverbrook with that of Janosky to incorporate a slitter in order to efficiently provide the required print size.

### ***Response to Arguments***

10. Regarding Applicant's remark that the use of plain paper would not have been obvious. As stated in the Advisory Action of December 11, 2008, Silverbrook, U.S. Patent Number 5,909,227, teaches that "inkjet printing has become recognized as a

prominent contender in the digitally controlled, electronic printing arena because, e.g., of...its use of plain paper" (column 3, lines 55-60). Examiner maintains the obviousness rejection. Enomoto teaches the use of a "well-known ink jet type color digital printer" (column 5, lines 43-52). It would have been obvious to one of ordinary skill in the art at the time of the invention to use plain paper in an ink jet printer in order to fulfill the customer's print order.

11. Regarding Applicant's remark that the limitations of "furnishing the printed plain paper image to the customer and charging the customer for the printing service," is not obvious. As stated in the Advisory Action of December 11, 2008, Enomoto teaches calculating the print charge and delivery date (column 2, lines 43-45). It is well known and obvious to deliver or furnish the print order to the customer on the delivery date and to charge them for the service after calculating the charge. Examiner maintains the reference.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

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4/11/09